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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,096

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David K. Swanson

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EXAMINER

ROANE, AARON F

ART UNIT

PAPER NUMBER

3769

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04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,096	Applicant(s) SWANSON, DAVID K.	
	Examiner Aaron Roane	Art Unit 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 10-12, 28-35, 37-40, 43, 46 and 54-59 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 11, 28, 30-35, 37-40, 43, 46 and 54-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 7 and 28 recite “the tissue stimulation element is not located within an inner space defined by the suction device, wherein the tissue stimulation element is a discrete tissue stimulation element that does not extend around the peripheral sealing surface.” Although the drawings suggest such subject matter, the detailed description of the invention does not.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 10, 11, 28, 30, 40, 43, 46, 47 and 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samson (U.S. Patent 6,185,442) in view of Geeham (U.S. Patent 5,295,481) in further view of Lundback (U.S. Patent 4,646,747).

Regarding claims 7, 11, 28, 30, 40 and 43, Samson discloses a flexible tube (flexible tube 15) defining a central axis and having a proximal end and a distal end; a suction device formed from a flexible material ("suction cup" 10 which is formed from a flexible material since it has a resilient wall 12), the suction device being connected to and coaxial with the distal end of the tube (portion 17) and having a flexible distal portion that includes a peripheral sealing surface (13) having a shape and a size for being removably securable to myocardial tissue, the suction device extending from the tube distal end such that the peripheral sealing surface is located distally of the tube distal end and extends outwardly beyond an outer surface of the tube distal end such that suction device across the peripheral sealing surface is wider than the tube distal end; and a tissue electrode ("electrode" 16) that is too small to form a transmural lesion in myocardial

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tissue; wherein the suction device does not carry an apparatus that is capable of forming a transmural lesion in myocardial tissue, see col. 3:36-col.4:57 and figures 1-7, particularly figures 1 and 3. Samson fails to disclose the peripheral sealing surface of the suction device is flexible and the tissue stimulation element being supported on the peripheral sealing surface of the distal portion of the suction device, such that the tissue stimulation element is not located within an inner space defined by the suction device, wherein the tissue stimulation element is a discrete tissue stimulation element that does not extend around the peripheral sealing surface. Samson also fails to disclose the tissue electrode is a tissue stimulation element/electrode and a source of stimulation energy operably connected to the stimulation element/electrode. Geeham discloses a suction device having a plurality of tissue contacting electrodes (32) and teach "defibrillation is provided by electrical contact between the patient's chest and two or more electrodes 32 located at the peripheral rim 30, and connected thereto by any practical means known in the art. As an example shown in FIGS. 3 and 4, the electrodes 32 may be U-shaped so as to fold around the peripheral rim 30 and then bolt to the suction cup member 20 via bolts 32'. In the examples shown in the Drawing, two pairs of electrodes 32a, 32b, and 32c, 33d are provided. The first set of electrodes 32a, 32b are connected to a low voltage circuit C.sub.1, have opposite polarity and are located at opposite positions on the peripheral rim 30. The second set of electrodes 32c, 3d are connected to a high voltage circuit C.sub.2, have opposite polarity and are located at opposite positions on the peripheral rim 30. Other electrode configurations are possible, and it is preferred for each set of electrodes to be well separated from any other set of electrodes. The upper end 16a of the column

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member 16 is provided with switches 34 and 36 which respectively control the low and high voltage circuits. These switches may be momentary (preferred for the high voltage circuit), or non-momentary (preferred for the low voltage circuit) on-off type switches, and they may be further associated with CPR assist device circuitry which provides periodic pretimed shocks of electricity to the electrodes, predetermined or user controlled levels of current, voltage and power to the electrodes. A transformer T provides a boost or reduction in the voltage, a transformer being optionally in either or both, the high and low voltage circuits,” see col. 3:27-58 and figures 1-4. Lundback discloses a surgical apparatus comprising an elongate flexible tube (8); a cup-shaped suction device (1-3 collectively) associated with the distal region of the tube, wherein the cup-shaped suction device is made from a flexible material (flexible bending portions of 2), a tissue electrode (the tissue contacting side of 30) on the suction device distal surface, see col. 3 and 4 and figures 1-4. Lundback teaches that the device is used as a diagnostic device or a therapeutic device, where the “diagnostic devices intended to be attached to the skin by means of the present vacuum-fixed holder are, for example, electrodes for electroencephalography (ECG), electrodes for electromyography (EMG), sensors for skin temperature, humidity, and pH, biosensors and other sensors for indirect or direct measurement of blood gases, intramuscular sensor probes for, e.g., measurement of local peripheral circulation by laser-Doppler techniques, microphones for the registration of heart sounds, optical conductors for observation of the skin, etc. Therapeutic devices intended to be attached to the skin by means of the present vacuum-fixed holder are, e.g., electrodes for electrical stimulation of muscles, defibrillators, injectors for intramuscular

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administration of pharmaceuticals, electrodes for hyperthermal treatment, devices for percutaneous administration of pharmaceuticals, etc.” Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Samson, as taught by Geeham, to provide the suction device with an alternate/equivalent embodiment where electrodes that are placed on a flexible peripheral distal surface of the suction cup and do not extend completely around the peripheral sealing surface in order to provide an improved electrical connection and conduction between the tissue and the electrode, and as further taught by Lundback, to provide the suction cup device with alternate use as a therapeutic device and using the electrode as a stimulation electrode, instead being used a diagnostic device using the electrode as a sensing electrode, and operably connecting the stimulation electrode to a source of stimulation energy.

Regarding claims 10 and 46, Samson discloses the suction device is substantially cup-shaped (10), see figures 1 and 3.

Regarding claim 47, Samson in view of Geeham in further view of Lundback disclose the claimed invention, where Samson discloses at least one conducting wire (18) extending through the tube and connected to the tissue electrode, which is used as a tissue stimulation electrode as taught by Lundback.

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Regarding claims 54-56, Samson in view of Geeham in further view of Lundback disclose the claimed invention, see in particular the electrodes 32a-32d and corresponding wires W) of Geeham in figure 4.

Regarding claims 57-59, Samson in view of Geeham in further view of Lundback disclose the claimed invention, see in particular the sealing surface of Geeham in figure 4.

Claims 31-33 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samson (U.S. Patent 6,185,442) in view of Geeham (U.S. Patent 5,295,481) in further view of Lundback (U.S. Patent 4,646,747) as applied to claims 7 and 28 above, and further in view of Ostroff et al. (U.S. Patent 7,149,575).

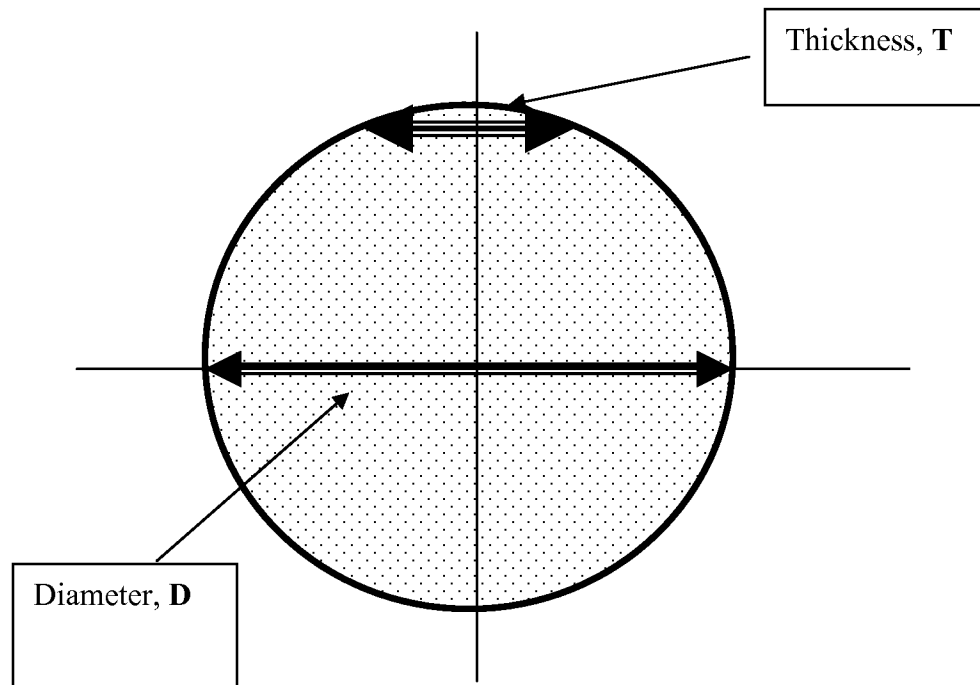
Regarding claims 31-33 and 37-39, Samson in view of Geeham in further view of Lundback disclose the claimed invention except for the stimulation element defining a perimeter of about 1.5 mm to 3 mm, a thickness of about 0.01 mm and a diameter of about 0.5 mm to 1.0 mm. The examiner takes official notice of the perimeter as it is trivial to provide the electrically conductive members, i.e. the electrodes of Geeham with perimeter of about 1.5 mm to 3 mm corresponding to the cross-sectional area of wires (W, see col. 3:65 – col. 4:18 and figure 4) and a thickness of about 0.01 mm in order to electrode with its fully functioning capabilities. It should be further noted that a circular perimeter of 1.5 mm to 3 mm yields a diameter of about 0.5 mm to 1 mm. As Applicant

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has traversed the official notice rejection, the examiner now provides a prior art reference which has been cited only to support the previous official notice rejection (see MPEP 2144.03(a-d), particularly 2144.03(d)). Specifically it is the cross-section of the electrode that is relevant for this rejection. Ostroff et al. disclose an electrical tissue stimulating device and provide an electrode having a circular cross-section with diameter of 1-5 mm, see col. 5:351-67 and figure 1. Since the perimeter, **P**, of the electrode cross-section is given by

$$\mathbf{P} = 2 * \pi * \mathbf{r} = \pi * \mathbf{D},$$

where **D** is the diameter and **r** is the radius. Therefore, in order for the perimeter, **P**, to be about 1.5 mm to 3 mm, the diameter, **D**, must be about 0.47mm to 0.95mm. Since 1mm is about 0.95mm (a difference of less than 5.3%), the perimeter and diameter recitations have been met. Regarding the thickness of about 0.01mm, it can easily be seen from the **figure A** below, given a circular cross-section, a thickness can be defined which the circular cross-section inherently has and that is about 0.01mm. Figure A depicts the electrode's circular cross-section having a diameter, **D** and thickness, **T**. It should be noted that thickness of 0.01mm is located almost at the top of the cross-section and for further illustration it should be noted the distance from the center of the circular cross-section to where the thickness is 0.01mm is equal to the square root of $(0.5\text{mm})^2$ minus $(0.005\text{mm})^2$.

**Figure A**

Finally, Applicant may argue Geeham doesn't disclose a circular cross-section. The examiner counters with the fact that a portion of the cross-section is circular (the upper portion) and it is that portion that defines (in view of the official notice and Ostroff et al. (7,149,575)) the recited dimensions.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samson (U.S. Patent 6,185,442) in view of Geeham (U.S. Patent 5,295,481) in further view of Lundback (U.S. Patent 4,646,747) as applied to claim 28 above, and further in view of Colliou et al. (U.S. Patent 7,020,531).

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Regarding claims 34 and 35, Samson in view of Geeham in further view of Lundback disclose the claimed invention except for explicitly reciting that the source of stimulation is configured to provide stimulation pulses that are about 1 msec in duration, 10 mA and two stimulation pulses per second. Colliou et al. disclose a stimulating suction electrode device and teach providing the device with a power source capable of delivering 1 mA to 30 mA of current, a pulse width of 0.1 msec to 500 msec and a pulse burst repetition period of about 100 μ sec to 20 msec in order to provide electrical stimulation, see col. 23, line 46 through col. 24, line 6 and figures 16A and 16B. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Samson in view of Geeham in further view of Lundback, as taught by Colliou et al., to provide the device with a power source capable of delivering 1 mA to 30 mA of current, a pulse width of 0.1 msec to 500 msec and a pulse burst repetition period of about 100 μ sec to 20 msec in order to provide electrical stimulation to tissue.

Response to Arguments

Applicant's arguments with respect to claims 7, 10, 11, 28, 30-35, 37-40, 43, 46, and 54-59 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment (particularly the amendment reciting suction applied through the flexible tube and

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the stimulation element not on the inner space of the suction device) necessitated the new ground(s) of rejection presented in this Office action.

The Geeham patent was used instead of the Starver patent to meet the newly recited subject matter.

As a courtesy to Applicant and in the hopes of expediting prosecution and specifically regarding Applicant's arguments/remarks on pages 8-10, section A, the examiner would like to comment in response. Due to Applicant's amendment to claims 7 and 28 regarding the suction applied through the flexible tube, it was necessary to provide a different and new interpretation of Samson to meet that recitation. More specifically, the flexible suction tube 15 meets the flexible tube, whereas previous to this amendment 17 was the flexible tube. Again Applicant's necessitated the new ground(s) of rejection via a different interpretation of the prior art.

Additionally, Applicant has provided much argumentation attacking the prior art references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art

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without any specific hint or suggestion in a particular reference. In re Bozek, 416 F .2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 8:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/
Examiner, Art Unit 3769

/Henry M. Johnson, III/
Supervisory Patent Examiner, Art Unit
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